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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,139	09/17/2003	John M. Beville	PTG 02-103-8	5799

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EXAMINER

LOPEZ, MICHELLE

ART UNIT PAPER NUMBER

3721

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/665,139	BEVILLE ET AL.	
	Examiner	Art Unit	
	Michelle Lopez	3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8-11, 30-32 and 35-38 is/are pending in the application.
- 4a) Of the above claim(s) 12-29 and 39-45 is/are withdrawn from consideration.
- 5) ☒ Claim(s) is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-11, 30-32 and 35-38 is/are rejected.
- 7) ☐ Claim(s) is/are objected to.
- 8) ☐ Claim(s) are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u> </u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u> </u> | 6) <input type="checkbox"/> Other: <u> </u> |

DETAILED ACTION

1. This action is in response to the amendment filed on March 3, 2005.
2. Claims 6, 7, 33, and 34 have been canceled.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the features of “a clutch assembly” as set forth in claim 38 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5, 8-11, 30-32, 35-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of claim 1 is unclear in that the result of the pivoting probe assembly locking in position is merely a function and positive structure to perform that function, i.e. the preventing further advancement of the nail, is not recited. If applicant intends to rely on the function, the structure performing it should be recited or it should be set forth in “means plus function” terms.

In claim 1, it is not clear what is meant by “the nail incorrectly engages the pivoting probe”. Also, it is not clear what is the “correct and incorrect position”?

In claims 30 and 32, it is not clear what is the “incorrect positioning of the nail”?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 30-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen (6,290,115).

Chen discloses the invention including a nail checker assembly for use with a nail loading assembly of a nail gun comprising means for engaging a nail advancing within the loading assembly; and means for hindering the nail from advancing if the positioning of the advancing nail is incorrect as shown in col. 2; lines 49-59.

With respect to claim 31, Chen discloses wherein the means for engaging a nail is a pivoting probe assembly via 22 coupled with a pivoting probe base assembly within a base assembly 20, wherein the pivoting probe assembly operationally engages with the advancing nail within the nail loading assembly 16.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 35 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (6,290,115) in view of Chen (6,431,428).

Chen'115 discloses the invention substantially as claimed except for an articulating pusher assembly.

However, Chen'428 teaches an articulating pusher assembly via 32 for the purpose of forwardly pushing the nails along a magazine feeding channel. In view of Chen'428, it would have been obvious to one having ordinary skills in the art to have provided Chen'115 invention with an articulating pusher assembly in order to forwardly push the nails along a magazine feeding channel.

With respect to claim 37, Chen'115 discloses wherein the nail gun is a pneumatic nail gun, but does not disclose that the nail gun is a spring-loaded nail gun, an electromagnetic nail gun, a combustion nail gun, and a motor driven nail gun. However, it would have been an obvious matter of design choice to have provided a nail gun consisting from a spring-loaded nail gun, an electromagnetic nail gun, a combustion nail gun, and a motor driven nail gun, since applicant has not disclosed that a spring-loaded nail gun, an electromagnetic nail gun, a combustion nail gun, and a motor driven nail gun solves any stated problem or is for any particular purpose and it appears that Chen'115 invention would perform equally well with a pneumatic nail gun for the purpose of properly powering a driving nail gun.

6. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (6,290,115) in view of Wohlwend et al. (6,685,078).

Chen'115 discloses the invention substantially as claimed except for a top-load magazine.

However, Wohlwend teaches a top load magazine via 3 for the purpose of providing a magazine that can be easily feed by both a right and a left handler operator without decoupling the magazine from the nail gun. In view of Wohlwend, it would have been obvious to one having

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ordinary skills in the art to have provided Chen's invention with a top load magazine in order to provide a magazine that can be easily feed by both a right and a left handler operator without decoupling the magazine from the nail gun.

7. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (6,290,115) in view of Shkolnikov et al. (6,739,490).

Chen'115 discloses the invention substantially as claimed except for a clutch assembly.

However, Shkolnikov et al. teaches a clutch assembly via 26 for the purpose of controlling a nail gun power when the nail gun is pressed against a workpiece. In view of Shkolnikov, it would have been obvious to one having ordinary skill in the art to have provided Chen'115 invention with a clutch assembly in order to control the nail gun power when the nail gun is pressed against a workpiece.

Allowable Subject Matter

8. Claims 1-5, 8-11, and 32 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and ^{regarding claim 32,} to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's arguments have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Chen (6,290,115).

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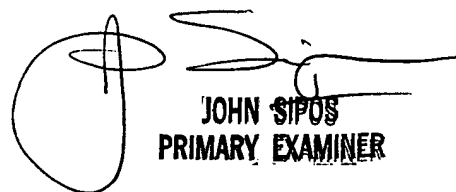
Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Lopez whose telephone number is 571-272-4464. The examiner can normally be reached on Monday - Thursday: 8:00 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML


JOHN SIPOS
PRIMARY EXAMINER